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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Applicant : Cedora Ruiz) Group Art Unit: 3751
Appl. No. : 10/762,843)
Filed : January 21, 2004)
For : WRITING IMPLEMENT)
Examiner : David J. Walczak)

I hereby certify that this correspondence and all marked attachments are being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on

January 5, 2007

(Date)

R. Scott Weide, Reg. No. 37,755

APPEAL BRIEF TRANSMITTAL

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Transmitted herewith is the Appeal Brief in this application, with respect to the Notice of Appeal filed on November 6, 2006.

Applicant claims small entity under 37 C.F.R. 1.9 and 1.27.

The fee for filing this Appeal Brief is \$250 for which a check in the amount of the fee is enclosed. **The Commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayment to Account No.: 502200. A duplicate copy of this sheet is enclosed.**

Respectfully submitted,

Dated: January 5, 2007

By:

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APPEAL BRIEF

I. REAL PARTY IN INTEREST

The subject application is owned by and the real party in interest is Cedora Ruiz (hereinafter Appellant).

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Appl. No. : 10/762,843
Filed : January 21, 2004

II. RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences.

Appl. No. : 10/762,843
Filed : January 21, 2004

III. STATUS OF CLAIMS

The application contains Claims 10-18, which claims are subject to this appeal.

In an action dated May 5, 2006, the Examiner finally rejected all of the pending claims.

Appl. No. : 10/762,843
Filed : January 21, 2004

IV. STATUS OF AMENDMENTS

No amendments have been filed subsequent to the final rejection of May 5, 2006.

Appl. No. : 10/762,843
Filed : January 21, 2004

V. SUMMARY OF CLAIMED SUBJECT MATTER

The Invention Generally

In general, the invention is a novelty writing implement. The writing implement comprises an outer housing and a tip from which writing material, such as ink, may be dispensed. Preferably, the housing is translucent, permitting an interior area to be viewed from the exterior of the implement. In one embodiment, the tip is located at a first end of the housing and a cap is located at an opposing second end. An ink cartridge or well or other writing material storage member extends from the tip into the interior of the housing.

A number of ornamental elements are located within an interior area defined by the housing, such as between the exterior of the well/cartridge and the interior of the housing. The ornamental elements are preferably small in maximum dimension relative to the dimension of the interior space.

The ornamental elements are viewable through the translucent housing of the implement. These elements may be utilized to create a novel appearance to the writing implement, which appearance may be customized (such as by the color, shape or arrangement of the ornamental elements in the interior of the housing). Moreover, the ornamental elements obscure the internal parts of the writing implement, such as the ink well/cartridge located therein.

Claims 10-18

Independent Claim 10 recites a writing implement (see Figures 1-3 at (20)). The implement comprises an elongate, generally cylindrical housing (Figure 1 at (22)) having a first end and a second end (Figure 1 at (24) and (26)) and comprising a substantially translucent material (Application at Paragraph [0027]). The implement includes a tip (Figure 1 at (32)) from which

Appl. No. : 10/762,843
Filed : January 21, 2004

writing material stored in a well or cartridge may be dispensed (Figure 1 at (38) and Application at Paragraphs [0030]-[0031]). The interior of the housing and the exterior of the well/cartridge define an otherwise open interior area (Figure 1 at (28) and Application at Paragraph [0028]) which is visible through the housing.

The implement further comprises a plurality of solid ornamental elements (Figures 1-3 at (40) and Application at Paragraphs [0033] - [0034]) which substantially fill the interior area between the first and second ends thereof and bounded by the exterior of the well/cartridge and the interior of the housing, whereby substantially only the solid ornamental elements are visible through the housing (Figures 1-3 and Application at Paragraphs [0035] - [0038]).

Claim 11 recites the implement of Claim 10 wherein the ornamental elements are all of a small size, namely, balls having a diameter in the range of .03125 to .125 inches (Application at Paragraph [0034]).

Claim 12 recites the implement of Claim 10 wherein the writing material comprises ink (Application at Paragraph [0031]).

Claims 13 and 14 recite the implement of Claim 10 wherein the ornaments have a size which is a fraction of a distance between the interior of the housing and the exterior of the well/cartridge, with a sufficient number of ornamental elements located in the interior space so that in one or more locations two or more layers of ornamental elements are positioned there between (See Figures 2 and 3 and Application at Paragraph [0035]).

Appl. No. : 10/762,843
Filed : January 21, 2004

Claims 15 and 16 recite the implement of Claim 10 wherein the ornamental elements are contained in, but not connect to, the housing, whereby their position may change (Application at Paragraph [0042]).

Claim 17 recites the implement of Claim 10 wherein the tip extends from the first end of the housing and closes the first end of the housing, and wherein the open interior is defined solely by the housing (Figure 5; Application at Paragraphs [0048] - [0051]).

Claim 18 recites the implement of Claim 10 wherein the housing comprises a single wall having an interior and an exterior and the interior space is defined by the wall (Figure 1).

Appl. No. : 10/762,843
Filed : January 21, 2004

VI. GROUND OF REJECTION TO BE REVIEWED ON APPEAL

There are two grounds of rejection presented for review.

(1) Claims 10 and 12-14 rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 3,250,033 to Siegel ("Siegel").

(2) Claims 10, 12 and 15-18 rejected as being anticipated by U.S. Patent No. 4,541,630 to Dirks ("Dirks")

Appl. No. : 10/762,843
Filed : January 21, 2004

VII. ARGUMENTS

Section 102 Rejections, Generally

In order for either Siegel or Dirks to anticipate the claims, every element of the claimed invention must be identically shown in that reference, and the elements must be arranged as in the claim under review. See In re Bond, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990) (emphasis added) and C.R. Bard, Inc. v. M3 Systems, Inc., 157 F.3d 1340 (Fed. Cir. 1380). It is thus important to consider the true teaching of Siegel and Dirks and the particular claim limitations and their arrangement. See Ecolochem, Inc. v. Southern California Edison Co., 227 F.3d 1361 (Fed. Cir. 2000) (the disclosure of the reference must not be misconstrued, including by picking and choosing among elements of the reference to “create” a different combination than is truly disclosed); Novo Nordisk A/S v. Becton Dickinson & Co., 96 F. Supp. 2d 309 (S.D.N.Y. 2000) (“It is not sufficient that each element be found somewhere in the reference, the elements must be ‘arranged as in the claim’.”); Gillette Co v. Warner-Lambert Co., 690 F. Supp. 115 (D. Mass. 1988) (“Not only must the claimed elements be presented in the prior device, but the elements must be found in substantially the same situation where they do substantially the same work.”).

A. Rejection of Claims 10 and 12-14 under 35 U.S.C. §102 over Siegel

By the Action, the Examiner rejected Claims 10 and 12-14 under 35 U.S.C. § 102(b) as being anticipated by Siegel (USPN 3,250,033). The Examiner asserts that Siegel discloses a writing pen comprised of a cylindrical transparent housing (23) having a tip with a well (13) and “a plurality of

Appl. No. : 10/762,843
Filed : January 21, 2004

solid ornamental elements 20, 22, 11, 14 substantially filling the interior bounded between the exterior of the well and the interior of the housing. . .” (May 5, 2006, Office Action at page 2).

Appellant asserts that Siegel does not meet the limitations of Claim 10. As detailed above, Claim 10 is directed to a writing implement with an interior area comprising a space bounded by an interior of a housing and an exterior of a well positioned therein, and including a plurality of solid ornamental elements located in that interior space. In the configuration as claimed, the plurality of ornamental elements are thus essentially the only elements which are visible through the housing, with the elements blocking or obscuring the well.

In general, Siegel discloses a ball point pen configured to display a message. Siegel thus discloses the pen as having a housing or barrel (see Siegel at col. 1 lines 53-55 and Figures 1, 2 and 5 at (11)). A ball point cartridge (13) may be located in the barrel (see Siegel at col. 1 lines 57-58 and Figure 1 at (13)). A sleeve which carries the message such as an advertisement or slogan is located over the exterior of the housing or barrel (see Siegel at col. 2, lines 1-12 and Figure 1 at (20)). A protective sleeve (23) may further be located over the “message sleeve”, also at the exterior of the housing or barrel (see Siegel at col. 2, lines 13-15 and Figure 1).

Siegel’s configuration is obviously quite different from the configuration as claimed. Siegel discloses a pen having a message-bearing sleeve and protective sleeve located over the exterior of the housing of a pen. The claimed invention comprises a writing implement having ornamental elements located inside the housing of the writing implement.

Appellant asserts that the Examiner has mis-construed Siegel in an attempt to make the elements of Siegel “fit” the claimed elements. In order to try and make Siegel meet the elements of

Appl. No. : 10/762,843
Filed : January 21, 2004

Claim 10, the Examiner asserts that the sleeve (23) of Siegel's pen comprises the housing claimed in Claim 10. Contrary to the Examiner's assertion, element (23) of Siegel is not a housing. Instead, as detailed above, Siegel explicitly discloses that element (23) is a "sleeve", which sleeve is itself superimposed over the actual housing or barrel of the pen (see Siegel at col. 1 lines 53-55 and Figures 1, 2 and 5 at (11)).

Further, in Siegel's configuration, as is clearly evident in Figure 1, there are no ornamental elements located in the interior space between the housing (11) and the exterior of the cartridge (13) as is explicitly required by Claim 10.

Appellant also asserts that Siegel does not disclose the invention as further claimed in Claims 13 and 14, wherein the ornamental elements are sized so that multiple layers of them are located between the housing and the well. First, Siegel does not disclose any elements located in the interior space between the housing (11) and the cartridge (13). Further, even if Siegel were cited for the principle of associating an ornamental element with a pen (albeit in a completely different form in which a sleeve is located at the exterior of a housing), at most Siegel discloses a single message-bearing sheet (sleeve (20)), and not multiple layers, as claimed.

B. Rejection of Claims 10, 12 and 15-18 under 35 U.S.C. §102 over Dirks

The Examiner also rejected Claims 10, 12 and 15-18 as being anticipated by Dirks (USPN 4,541,630). The Examiner asserts that Dirks discloses a writing implement having a transparent, cylindrical housing (30), a tip for dispensing ink from a well (15) and "ornamental elements 24, 40

Appl. No. : 10/762,843
Filed : January 21, 2004

substantially filling the area bounded between the exterior of the well and the interior of the housing . . .” (See May 5, 2006, Office Action at page 3).

Again, Appellant asserts that Dirks does not meet the elements of Claim 10.

In general, Dirks discloses a pen with a random number generator. As such, Dirks’ pen has body (11) (see Dirks at col. 2, line 10 and Figure 1). A central member (22) is connected to the top of the body (see Dirks at col. 2, lines 17-27 and Figure 1). The central member (22) includes a cylindrical portion (24) located in a sleeve (30) (see Dirks at col. 2, lines 22-25 and Figure 4). A small number of balls (40) are configured to be received at the exterior of the cylindrical portion (24) beneath the sleeve (30), such as in slots (37,38) in the cylindrical portion (see Dirks at col. 2, lines 35-44 and Figures 1-5).

In Dirks, both the balls (40) and the pen’s well or refill (15) are located in the sleeve (30), but the balls (40) are not located in an interior space which is defined by the exterior of the refill and the interior of the sleeve, but instead in spaces defined between the sleeve (30) and portion (24). As indicated above, Claim 10 requires that the ornamental elements be located in an interior space which is otherwise open and defined between the exterior of the well and the interior of the housing. In Dirks, the area inside the housing (30) is not otherwise open (since it is filled with in the central member (24) and moreover, the ornamental elements are not located at the exterior of the well (15) inside the housing (it is evident that there is an open space exterior to the well (15) and that the balls (40) are located exterior to the central member (24)).

In addition, balls (40) are not arranged to so substantially fill the interior area so that they are the only elements visible through the housing and so that they otherwise obscure the well (or refill

Appl. No. : 10/762,843
Filed : January 21, 2004

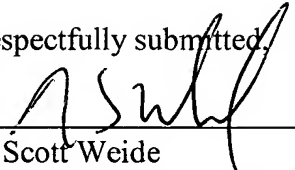
(15)). Instead, owing to Dirks' balls (40) being provided for use as random number generators, elements (such as portion 24) other than the balls (40) are visible through the housing (and the balls (40) are only located in portions of the slots at the exterior of the central member (24)).

Appellant also asserts that Dirks does not disclose various other aspects of the invention claimed in other of the claims. For example, relative to Claim 17, Appellant asserts that Dirks does not disclose a writing implement in which ornamental elements fill an interior area between a tip and a second end of a housing. In Dirks, balls are located only at certain exterior areas of a secondary cylindrical portion of the pen.

Summary

Appellant asserts that the cited prior art, Siegel and Dirks, do not disclose the elements of the claims, when those references and the limitations of the claims are properly construed and considered. As such, Appellant requests allowance of all the pending claims for the reasons advanced above.

Dated: January 5, 2007

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Appl. No. : 10/762,843
Filed : January 21, 2004

VIII. CLAIMS APPENDIX

10. A writing implement comprising an elongate, generally cylindrical housing having a first end and a second end, said housing comprising a substantially translucent material, said second end of said housing and said interior closed, said implement including a tip configured to dispense writing material stored in a well, said well containing writing material extending from said tip into said housing, an interior of said housing and an exterior of said well defining an otherwise open interior area which is visible through said housing, said implement further including a plurality of solid ornamental elements substantially filling said interior area between said first end and second end of said housing and bounded by said exterior of said well and said interior of said housing, whereby substantially only said solid ornamental elements are visible through said housing, said solid ornamental elements generally obscuring said well within said housing.

11. The writing implement in accordance with Claim 10 wherein said ornamental elements comprise balls having a diameter in the range of about .03125 - .125 inches.

Appl. No. : 10/762,843
Filed : January 21, 2004

12. The writing implement in accordance with Claim 10 wherein said writing material comprises ink.

13. The writing implement in accordance with Claim 10 wherein said ornamental elements have a size which is a fraction of a distance between said interior of said housing and said exterior of said well, and a sufficient number of said ornamental elements are positioned within said interior area that in one or more locations two or more layers of said ornamental elements are positioned between said interior of said housing and said exterior of said well.

14. The writing implement in accordance with Claim 13 wherein said ornamental elements have a size in relation to said distance between said interior of said housing and said exterior of said well that at least three ornamented elements fit within said distance.

15. The writing implement in accordance with Claim 10 wherein said ornamental elements are contained within, but not connected to, said housing, whereby a position of said ornamental elements may change relative to said housing.

16. The writing implement in accordance with Claim 15 wherein said ornamental elements may change positions relative to one another and said housing in response to movement of said housing.

Appl. No. : 10/762,843
Filed : January 21, 2004

17. The writing implement in accordance with Claim 10 wherein said tip extends from said first end of said housing and closes said housing at said first end, whereby said opening interior is defined solely by said housing and wherein said ornamental elements are located in said interior space between said tip and said second end of said housing.

18. The writing implement in accordance with Claim 10 wherein said housing comprises a single wall having an exterior and an interior and said interior space is defined by said wall.

Appl. No. : 10/762,843
Filed : January 21, 2004

IX. EVIDENCE APPENDIX

There are no exhibits attached hereto.

Appl. No. : 10/762,843
Filed : January 21, 2004

X. RELATED PROCEEDINGS APPENDIX

There are no related proceedings.